<u>REMARKS</u>

Claims 1-13, 16-36 and 40-43 are pending in the Application. Claim 23 is allowable if rewritten to overcome the rejection under 35 U.S.C. §101. Claims 8-11, 21 and 31-34 are objected. Further, claims 1-7, 12, 13, 16-20, 22-30, 35, 36 and 40-43 are rejected under 35 U.S.C. §101. Additionally, claims 42 and 43 are rejected under 35 U.S.C. §112, second paragraph. Furthermore, claims 1-7, 12, 13, 16-20, 22, 24-30, 35, 36 and 40-43 under 35 U.S.C. §103(a). Applicants address these objections and rejections below.

Applicants thank Examiner Campbell for discussing this Office Action with Applicants' attorney, Bobby Voigt, on September 10 and 11, 2009.

I.   <u>OBJECTIONS TO THE CLAIMS:</u>

The Office Action has objected to claims 8-11, 21 and 31-34 under 37 C.F.R. §1.75(c) as being in improper form because a multiple dependent claim may not depend on any other multiple dependent claim. Office Action (7/6/2009), page 3. As indicated above, Applicants amended claims 8-11, 21 and 31-34 to remove the dependency upon multiple dependent claims. Accordingly, Applicants kindly request the Examiner to withdraw the objections to the claims.

Claims 8-11, 21 and 31-34 were amended to correct typographical mistakes and were not amended to overcome prior art. Hence, no prosecution history estoppel arises from the amendments to claims 8-11, 21 and 31-34. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 8-11, 21 and 31-34 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

II.   <u>REJECTIONS UNDER 35 U.S.C. §101:</u>

The Office Action has rejected claims 1-7, 12, 13, 16-20, 22-30, 35, 36 and 40-43 under 35 U.S.C. §101 as being allegedly directed to non-statutory subject

matter. Office Action (7/6/2009), page 3. In particular, the Office Action has rejected claims 1-7, 12 and 13 under 35 U.S.C. §101 in light of *In re Bilski*. *Id*. The Examiner states that the process claims (1-7, 12 and 13) must (1) be tied to a particular machine or apparatus or (2) transform the underlying subject matter (such as an article or material) into a different state or thing. *Id*. As indicated above, Applicants amended claims 1, 3, 4 and 12 to include the aspect of a processor performing one of the method steps. Therefore, process claims 1-7, 12 and 13 satisfy the test laid out in *In re Bilski* and are directed to statutory subject matter.

Additionally, the Office Action has rejected claims 16-20, 22-30 and 35 as being directed to non-statutory subject matter since they are not tangibly embodied in a manner so as to be executable. Office Action (7/6/2009), page 4. As indicated above, Applicants amended computer program product claims 16, 22, 23, 24, 26 and 27 to include the aspect of being embodied in a computer readable medium. Further, as indicated above, Applicants amended the Specification to remove language directed to a carrier signal. Accordingly, claims 16-20, 22-30 and 35 are directed to statutory subject matter.

Furthermore, the Office Action has rejected claims 40-43 as being directed to non-statutory subject matter since they are not tangibly embodied in a manner so as to be executable. Office Action (7/6/2009), page 4. The Office Action suggests that Applicants include the aspect of a processor and a memory in the claims to overcome this rejection. *Id*. As indicated above, Applicants amended claims 40-42 to include the aspect of a processor and a memory. Accordingly, claims 40-43 are directed to statutory subject matter.

As a result of the above, claims 1-7, 12, 13, 16-20, 22-30, 35, 36 and 40-43 are directed to statutory subject matter. Applicants kindly request the Examiner to withdraw the rejections to claims 1-7, 12, 13, 16-20, 22-30, 35, 36 and 40-43 under 35 U.S.C. §101.

Claims 1, 3, 4, 12, 16, 22, 23, 24, 26, 27 and 40-42 were not amended to overcome prior art. Hence, no prosecution history estoppel arises from the amendments to claims 1, 3, 4, 12, 16, 22, 23, 24, 26, 27 and 40-42. *Festo Corp. v.*

Shoketsu Kinzoku Kogyo Kabushiki Co., 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 1, 3, 4, 12, 16, 22, 23, 24, 26, 27 and 40-42 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

III.   REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH:

The Office Action has rejected claims 42 and 43 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Office Action (7/6/2009), page 4. In particular, the Office Action asserts that the claim limitations that use the "means for" language are modified by some structure, material, or acts recited in the claims. *Id.* While Applicants do not believe that the "means for" claim limitations are modified by some structure, material, or acts recited in the claims, Applicants did amend claims 42 and 43 to remove the "means for" language. Accordingly, claims 42 and 43 are definite and distinctly claim the subject matter which Applicants regard as the invention. As a result, Applicants kindly request the Examiner to withdraw the rejections of claims 42 and 43 under 35 U.S.C. §112, second paragraph.

Claims 42 and 43 were not amended to overcome prior art. Hence, no prosecution history estoppel arises from the amendments to claims 42 and 43. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 42 and 43 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

IV.   REJECTIONS UNDER 35 U.S.C. §103(a):

The Office Action has rejected claims 1-7, 12, 16-17, 19, 24-30, 35, 40 and 42-43 under 35 U.S.C. §103(a) as being unpatentable over Word '97, 1996 Microsoft

Corporation, screenshots pages 1-16 (hereinafter "Word '97"). Further, the Office Action has rejected claims 13, 18, 20, 22, 36 and 41 under 35 U.S.C. §103(a) as being unpatentable over Word '97 in view of Turbo C++ Version 4.5, 1995 Borland International, screenshots pages 1-7 (hereinafter "Borland"). Applicants respectfully traverse these rejections for at least the reasons stated herein and respectfully request the Examiner to reconsider and withdraw these rejections.

A.   Claims 1-7, 12, 16-17, 19, 24-30, 35, 40 and 42-43 are patentable over Word '97.

1.   Claims 1 and 24 are patentable over Word '97.

The Office Action cites pages 2 and 9 of Word '97 as teaching "receiving a user example; and formatting the non-functional aspects of said document in the style of said user example" as recited in claim 1 and similarly in claim 24. Office Action (7/6/2009), page 6. The Office Action further states:

> Word '97 analyzes the following user example input: "Dear John," at which the system determines that one is attempting to write (format) a letter. A user chooses to get help, resulting in the appearance of Letter Wizard for final formatting and styling (Word '97 pages 10-15). Word '97 does not specifically disclose formatting non-functional aspects in the style of said example, as claimed. However, page 10 of Word '97 teaches a "Full block" letter style (incorporating non-functional block indent/groupings) as a default choice, which attempts to approximate the letter style display of said user input, therefore providing the claimed equivalent of formatting non-functional aspects in the style of user example input...It would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word '97 in this fashion, providing Word '97 the benefit of offering various style selections for convenience of document construction. Office Action (7/6/2009), page 6.

Applicants respectfully traverse the assertion that Word '97 teaches the above-cited claim limitations. Word '97 instead teaches that a "Letter Wizard" appears in response to "Dear" or "To" followed by a colon or a comma with a person's name disposed between the two. Word '97, page 7. Word '97 has not received a user's example. Instead, Word '97 has received input from a user starting to type out a letter. Furthermore, Word '97 further teaches that the Letter Wizard asks the user if the user would like help writing the letter. Word '97, page 9. If the user chooses to

receive help, the Letter Wizard presents various letter style options. Word '97, page 10. These are predetermined styles which are not related to the non-functional aspects of a document in the style of a user example. Indeed, the only input that has been received is the "Dear John," which contains no style information whatsoever. Additionally, the "Dear John" is a functional and not a non-functional aspect of the user input. Thus, the teaching in Word '97 does not support the Office Action's contention that the "Full block" letter style as a default choice attempts to approximate the letter style display of the user input. The displayed letter style is simply the first style displayed from a set of choices as indicated by the drop-down menu in the Letter Wizard dialog box. Word '97, page 10. Therefore, the cited passages of Word '97 do not teach the above-cited claim limitations in claims 1 and 24 as asserted by the Office Action.

Further, the Office Action maintains that the screenshot on page 9 (simply shows "Dear John," on a blank sheet of paper) is indicative of a "style" of type "letter." Office Action (7/6/2009), page 6. The Office Action must provide a basis in fact and/or technical reasoning to support the assertion that a blank page that shows "Dear John," is a style. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Office Action must provide extrinsic evidence that must make clear that a blank page that shows "Dear John," is a style, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Office Action has not provided any such objective evidence, the Office Action has not presented a *prima facie* case of obviousness for rejecting claims 1 and 24. M.P.E.P. §2112.

Furthermore, the Office Action admits that Word '97 does not teach "non-functional" aspects. Office Action (7/6/2009), page 6. The Office Action asserts that the Letter Wizard's "Full Block" letter style (page 10) can fit within the letter style of Word '97 (page 9), therefore suggesting the arrangement of non-functional aspects. *Id.* Applicants respectfully traverse the assertion that by the user selecting a particular letter style is the same as formatting non-functional aspects of a document in the style of a user example. Firstly, the "Full Block" letter style is not a style of a user example. Secondly, there are no non-functional aspects in the blank page with

the words "Dear John" to be formatted. The Office Action must provide a basis in fact and/or technical reasoning to support the Office Action's assertion. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Office Action must provide extrinsic evidence that must make clear that a user selecting a particular letter style is the same as formatting non-functional aspects of a document in the style of a user example, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Office Action has not provided any such objective evidence, the Office Action has not presented a *prima facie* case of obviousness for rejecting claims 1 and 24. M.P.E.P. §2112.

Additionally, in order to establish a *prima facie* case of obviousness, the Examiner must provide articulated reasoning with some rational underpinning. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)). The Office Action asserts, as previously discussed, that it would have been obvious to one of ordinary skill in the art to interpret Word '97 as attempting to approximate the letter style display of the user input thereby providing the claimed equivalents of formatting non-functional aspects in the style of the user example. Office Action (7/6/2009), page 6. An interpretation of a reference is not a modification of a reference. Furthermore, the rationale for interpreting Word '97 in the aforementioned fashion is to provide Word '97 the benefit of offering various style selections for convenience of document construction. Office Action (7/6/2009), page 6. However, there is no reason to modify Word '97 to provide the benefit offering various style selections for convenience of document construction because Word '97 offers a choice of predetermined letter styles via a drop-down menu as explicitly shown therein. Word '97, page 10. Hence, the Office Action's rationale does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Word '97 to include the missing claim limitation of claims 1 and 24. Accordingly, the Office Action has not presented a *prima facie* case of obviousness for rejecting claims 1 and 24. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

2.   Claims 2 and 25 are patentable over Word '97.

The Office Action cites pages 10, 11 and 14 of Word '97 as teaching "wherein said non-functional aspects include indentation, order, and comment style" as recited in claim 2 and similarly in claim 25. Office Action (7/6/2009), page 7. Applicants respectfully traverse and assert that Word '97 instead teaches "Full block" and "Modified block" indentation styles, as well as header and footer inclusions and space for inputting mailing instructions, attention and subjects. However, these are not non-functional aspects formatted in a style of a user example. Indeed, the only user input identified in Word '97 is "Dear John," which shows that the "Full block" and "Modified block" indentation styles are not formatting in the style of the user example. Therefore, the cited passages of Word '97 do not teach the above-cited claim limitation in claims 2 and 25 as asserted by the Office Action.

3.   Claims 3 and 26 are patentable over Word '97.

The Office Action rejects the limitation of "receiving from a user an example document; selectively generating from said example document style templates, alignment offsets and section order; and responsive to said templates, offsets and order, formatting functional aspects of said output document" as recited in claim 3 and similarly in claim 26 under the same rationale as rejecting claim 1. Office Action (7/6/2009), page 7. The Office Action further cites pages 4, 10 and 11 of Word '97 as allegedly teaching the generation of various style templates based upon a user's initial attempt at writing a letter. Office Action (7/6/2009), page 7. However, the user's attempt at writing a letter is not a step of receiving from a user an example document. Instead, Word '97 pops up a Letter Wizard in response to the user inputting a salutation in a very specific format. In other words, Word '97 performs a pattern match to pop up the Letter Wizard which then offers some exemplary predetermined document styles from which the user can select. These are not selectively generated from the example document. There is no example document received from the user.

Therefore, the cited passages of Word '97 do not teach the above-cited claim limitations in claims 3 and 26 as asserted by the Office Action.

The Office Action also asserts that Word '97 teaches reformatting of inputted text and inclusion of macros to fit the form of a selected letter style. Office Action (7/6/2009), page 7. Again, the selected letter style is not an example document received from a user. Furthermore, macros are sets of actions that automate the performance of repetitive operations. Macros are not functional aspects of the output document. Therefore, the cited passages of Word '97 do not teach the above-cited claim limitations in claims 3 and 26 as asserted by the Office Action.

With respect to the alignment offsets and section order as recited in claim 3, the Office Action admits that Word '97 does not teach alignment offsets. Office Action (7/6/2009), page 7. The Office Action asserts though that "Modified Block" style includes block indentations (Word '97 page 11), that provide the claimed equivalent of alignment offsets. *Id.* Applicants respectfully traverse. The screen shots in Word '97 depicting the "modified block" letter style do not appear to show block indentations at all as asserted by the Office Action. Word '97, page 11. The depiction of the text in the letter style appears to be fully justified with paragraphs separated by additional line spacing and without indentations. Word '97, page 11. Therefore, the cited passages of Word '97 do not teach the above-cited claim limitations in claims 3 and 26 as asserted by the Office Action.

Furthermore, the Office Action states that it would have been obvious to interpret Word '97 as incorporating offsets providing the benefit of various letter styles for convenience. Office Action (7/6/2009), page 7. Applicants respectfully traverse. There is no suggestion in Word '97 to selectively generate from an example document style templates, alignment offsets and section order. Neither is there any suggestion in Word '97 in response to such templates, offsets and order, to format functional aspects of an output document. Furthermore, there is no suggestion in Word '97 to selectively generate from an example document style templates, alignment offsets and section order and in response to such templates, offsets and order, to format functional aspects of an output document in order to provide the benefit of various letter styles for convenience (Office Action's reasoning). The Office Action's reasoning does not address as to why one of ordinary skill in the art would have been motivated to modify the teachings of Word '97 to selectively

generate from an example document style templates, alignment offsets and section order and in response to such templates, offsets and order, to format functional aspects of an output document. Accordingly, the Office Action has not presented a *prima facie* case of obviousness for rejecting claims 3 and 26. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

<div align="center">4.   <u>Claims 4, 27 and 42 are patentable over Word '97.</u></div>

The Office Action rejects the limitations of "capturing the user preferred style from a user example document; and generating a plurality of templates, each said template representing a component of said user example document and selectively including replaceable macros" as recited in claim 4 and similarly in claims 27 and 42 under the same rationale as rejecting claim 3. Office Action (7/6/2009), page 7. The Office Action further states that Word '97 does not specifically disclose replaceable macros in an output document. *Id.* at page 8. However, the Office Action asserts that pages 4 and 16 of Word '97 teach macro inclusion in templates and a method of selecting alternate salutations. *Id.* Applicants respectfully traverse.

Selecting alternate salutations from a drop-down menu is not selectively including replaceable macros. *See* Word '97, page 16. A salutation pasted into a document from a drop-down menu is not a macro. Further, there is no language in Word '97 that teaches generating a plurality of templates where each template represents a component of a user example document. Further, there is no language in Word '97 that teaches capturing a user preferred style from a user example document. Therefore, the cited passages of Word '97 do not teach the above-cited claim limitations in claims 4, 27 and 42 as asserted by the Office Action.

Furthermore, the Office Action states that it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word '97 as teaching the above-cited claim limitations "providing Word '97 the benefit of macros for convenient display of alternate text." Office Action (7/6/2009), page 8. Applicants respectfully traverse. There is no language in Word '97 that suggests generating a plurality of templates where each template represents a component of the user example document and selectively including replaceable macros. Furthermore,

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there is no language in Word '97 that suggests generating a plurality of templates where each template represents a component of the user example document and selectively including replaceable macros in order to provide the benefit of macros for convenient display of alternate text (Office Action's reasoning). The Office Action's reasoning does not address as to why one of ordinary skill in the art would have been motivated to modify the teachings of Word '97 to generate a plurality of templates where each template represents a component of the user example document and selectively including replaceable macros. Accordingly, the Office Action has not presented a *prima facie* case of obviousness for rejecting claims 4, 27 and 42. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

<div align="center">5.   <u>Claims 5, 28 and 43 are patentable over Word '97.</u></div>

The Office Action cites pages 4, 11-12 and 16 of Word '97 as teaching "generating functional aspects; replacing said macros in said template with information from said functional aspects; and responsive to said template with information from said functional aspects, generating said output document" as recited in claim 5 and similarly in claims 28 and 43. Office Action (7/6/2009), page 8. In particular, the Office Action asserts that Word '97 teaches reformatting of inputted text and the inclusion of macros (functional aspects) to fit the form of the selected letter style. *Id.* Further, the Office Action relies on the teaching in Word '97 (citing pages 4, 13 and 16 of Word '97) for selecting alternate salutations using a drop-down menu. *Id.* Applicants respectfully traverse.

Whether Word '97 teaches reformatting of inputted text and the inclusion of macros to fit the form of a selected letter style, or otherwise, these allegations do not address the limitations of claim 5. Claim 5 does not recite reformatting inputted text and the inclusion of macros to fit a form of selected letter style. Likewise, the limitations of claim 5 do not recite selecting alternate salutations. Claim 5 recites, *inter alia*, replacing macros in a template with information from the functional aspects, and responsive to the template with information from the functional aspects, generating the output document. All words in a claim must be considered when judging the patentability of the claim against the prior art. *In re Wilson*, 424 F.2d

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1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. 2143.03. Since the Office Action has not considered the language in the above-cited claim limitations, the Office Action has not appropriately judged the patentability of the claim against the prior art. Therefore, the cited passages of Word '97 do not teach the above-cited claim limitations in claims 5, 28 and 43 as asserted by the Office Action.

6.   Claims 6 and 29 are patentable over Word '97.

The Office Action cites page 2 of Word '97 as teaching "applying syntactical patterns to said user example document to define said component" as recited in claim 6 and similarly in claim 29. Office Action (7/6/2009), page 8. In particular, the Office Action asserts that page 2 of Word '97 teaches analysis of user input "Dear John," the analysis dependent upon syntactical review of the punctuation of the input. *Id.* Applicants respectfully traverse.

Word '97 states that if a salutation starts with "Dear" or "To" and followed by a colon or comma, Word '97 pops up a Letter Wizard that allows the user to select a letter style from a predetermined set of letter styles using a drop-down menu. There is no particular implementation described in Word '97. The Office Action must provide a basis in fact and/or technical reasoning to support the Office Action's assertion that popping up a Letter Wizard teaches applying syntactical patterns to the user example document to define the component. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Office Action must provide extrinsic evidence that must make clear that popping up a Letter Wizard teaches applying syntactical patterns to the user example document to define the component, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Office Action has not provided any such objective evidence, the Office Action has not presented a *prima facie* case of obviousness for rejecting claims 6 and 29. M.P.E.P. §2112.

7.   Claims 7 and 30 are patentable over Word '97.

The Office Action cites pages 14 and 16 of Word '97 as teaching "temporarily removing comments from said user example document when applying said syntactical patterns to said user example document" as recited in claim 7 and

similarly in claim 30. Office Action (7/6/2009), page 8. In particular, the Office Action rejects claim 7 on the basis that pages 14 and 16 of Word '97 teach alteration of "mailing instructions," "Attention," and "Subject" fields as well as creating auto text after applying pattern matching. *Id.* Applicants respectfully traverse.

While Word '97 may teach alteration of "mailing instructions," "Attention," and "Subject" fields, by selecting an option from a list box in a dialog window, this is not the same as temporarily removing comments from the user example document when applying syntactical patterns to the example document, as recited in claim 7. It would be appreciated by persons of ordinary skill in the art that selecting elements in a list box, such as a reference line or a subject field, simply copies the text in the list box into the letter being written. *See* Word '97, pages 14, 16 (illustrating the Letter Wizard dialog box and list box contained therein). Similarly, creating auto text does not teach the limitations of claim 7. As stated in Word '97, creating auto text allows the user to add names to a list of names and text to be used in standard letter elements. Word '97, page 5. Therefore, the cited passages of Word '97 do not teach the above-cited claim limitations in claims 7 and 30 as asserted by the Office Action.

8.   Claims 12 and 35 are patentable over Word '97.

The Office Action rejects the limitations of "receiving a user example document; while parsing document components in said user example document, preserving the relative indentation of subcomponents by calculating user desired offsets for said subcomponents; and responsive to said user desired offsets, generating said output document" as recited in claim 12 and similarly in claim 35 under the same rationale for rejecting claim 3. Office Action (7/6/2009), page 8.

In particular, the Office Action asserts that page 11 of Word '97 teaches a "Modified block" style template that allegedly comprises various calculated block indents in which the desired application of the template to a user document preserves the indents to produce a final document. Office Action (7/6/2009), page 9. Applicants respectfully traverse and assert that Word '97 instead teaches a sample letter style including a modified block letter style selected from a set of predetermined letter styles. Word '97, page 11. There is no language disclosed in the

cited passage of Word '97 that teaches calculating various block indents as asserted by the Office Action. Neither does this passage teach receiving a user example document. Neither does this passage teach preserving the relative indentation of subcomponents while parsing document components in the example document. Neither does this passage teach generating the output document responsive to the user desired offsets.

Furthermore, the Office Action admits that Word '97 does not teach parsing components. Office Action (7/6/2009), page 9. The Office Action contends that Word '97 teaches analyzing user inputted words and punctuation which provides the claimed equivalent of parsing text components. *Id.* Applicants respectfully disagree.

As previously discussed, Word '97 detects the presence of a "Dear" or "To" followed by a comma or colon, and launches the Letter Wizard in response thereto. This is not the same as parsing document components in a user example document. The Office Action must provide a basis in fact and/or technical reasoning to support the assertion that launching a Letter Wizard teaches parsing components. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Office Action must provide extrinsic evidence that must make clear that launching a Letter Wizard teaches parsing components, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Office Action has not provided such evidence, the Office Action has not presented a *prima facie* case of obviousness in rejecting claims 12 and 35. M.P.E.P. §2112.

As also previously discussed, there is no user example document disclosed in Word '97. Thus, the Office Action's conclusion that it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word '97 as providing the equivalent of parsing text components is not justified.

Furthermore, the Office Action asserts that it would have been obvious to one of ordinary skill in the art to interpret Word '97 to make the invention of claim 12 thereby providing the benefit of analysis/matching for presentation of various templates. Office Action (7/6/2009), page 9. Applicants respectfully traverse. The

Office Action has not provided any rational underpinning to support such a rationale. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 12 and 35. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

9.   Claims 16 and 40 are patentable over Word '97.

The Office Action rejects the limitations of "a style capture tool for examining an input document containing an example of said user preferred style to determine said user preferred style for non-functional aspects of said output document; a code generation tool for generating functional aspects of said output document; and a document generate tool responsive to said style capture tool and said code generation tool for generating said output document with said preferred style for non-functional aspects applied to the presentation of said functional aspects" as recited in claim 16 and similarly in claim 40 under the same grounds as rejecting claim 3. Office Action (7/6/2009), page 9. However, as an initial matter, the limitations of claims 16 and 40 do not only parallel the limitations of claim 3 as computer constructions for performing the methods of claim 3 as asserted by the Office Action. For example, claim 3 does not recite determining a user preferred style for non-functional aspects of an output document generating functional aspects of the output document (claim 3 recites formatting functional aspects of the output document) or generating the output document with the preferred style for non-functional aspects applied to the presentation of the functional aspects. These elements of claim 16 have not been expressly addressed. The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. M.P.E.P. §2142. Since the Examiner has not met his burden of presenting evidence that Word '97 teaches all of the limitations of claims 16 and 40, the Office Action has not presented a *prima facie* case of obviousness in rejecting claims 16 and 40. M.P.E.P. §2142.

Furthermore, the Office Action states that while Word '97 does not specifically disclose formatting non-functional aspects in the style of the example, page 10 of Word '97 teaches a "Full block" letter style as a default choice. Office Action (7/6/2009), page 9. There is no language in claim 16 that recites "formatting

non-functional aspects." All words in a claim must be considered when judging the patentability of the claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. 2143.03. Since the Office Action has ignored claim language from claims 16 and 40, the Office Action has not presented a *prima facie* case of obviousness in rejecting claims 16 and 40. M.P.E.P. §2143.

Furthermore, Applicants respectfully traverse the assertion that page 10 of Word '97 teaches any of the limitations of claim 16. Instead, Word '97 teaches that the Letter Wizard offers the user a drop-down menu selection of predetermined letter styles. Word '97, page 10. Thus, the "Full block" letter style does not attempt to approximate the letter style display of the user input, but is simply one choice from a predetermined set of choices of letter style offered to the user by Word '97. Consequently, there is no justification for interpreting Word '97 to teach the limitations of claims 16 and 40. Therefore, the cited passages of Word '97 do not teach the above-cited claim limitations in claims 16 and 40 as asserted by the Office Action.

Furthermore, the Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word '97 as teaching the limitations of claim 16 since it would provide Word '97 the "benefit of offering various style selections or convenience of document construction." Office Action (7/6/2009), page 9. Applicants respectfully traverse. The Office Action has not provided any rational underpinning to support such a rationale. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 16 and 40. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

10.   Claim 17 is patentable over Word '97.

The Office Action cites page 2 of Word '97 as teaching "a grammar template for storing syntax rules; and said style capture tool being responsive to said syntax rules for pattern-matching said user example document" as recited in claim 17. Office Action (7/6/2009), page 10. In particular, the Office Action asserts that Word

'97 teaches analysis of user input "Dear John," in which the analysis is dependent upon syntactical and pattern matching review of words and punctuation of the input. *Id.* Applicants respectfully disagree that the analysis is dependent upon syntactical matching, and moreover, that notwithstanding, there is no disclosure in Word '97 with respect to a grammar template. As Applicants have previously discussed, Word '97 teaches that the Letter Wizard is launched in response to the user inputting "Dear" or "To" followed by a comma or a colon. Word '97, page 7. The Letter Wizard will not start if anything else is entered. *Id.* The starting of Letter Wizard can be responsive to a simple pattern matching and need not rely on syntactical rules. Therefore, the cited passages of Word '97 do not teach the above-cited claim limitations in claim 17 as asserted by the Office Action.

Furthermore, the Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word '97 as teaching the limitations of claim 17 since it would provide Word '97 the "benefit of rules for making accurate analysis." Office Action (7/6/2009), page 10. Applicants respectfully traverse. The Office Action has not provided any rational underpinning to support such a rationale. Accordingly, the Office Action has not presented a *prima facie* case of obviousness for rejecting claim 17. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

11.   Claim 19 is patentable over Word '97.

The Office Action has rejected the limitations of "a plurality of input document files, each said input document file representing a user preferred style for different parts of said output document" as recited in claim 19 based on the teaching in Word '97 of a Letter Wizard that can be used to modify or complete existing letters, each letter capable of incorporating various customized template portions. Office Action (7/6/2009), page 10. Whether Word '97 teaches such, a Letter Wizard or otherwise, is immaterial to the rejection of claim 19. Claim 19 recites a plurality of input document files, each input document file representing a user preferred style for different parts of the output document. The Office Action must consider all words in a claim when judging the patentability of the claim against the prior art. *In re Wilson,*

424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. 2143.03. Since the Office Action ignored the language in claim 19 in judging the patentability of claim 19, the Office Action has not presented a *prima facie* case of obviousness in rejecting claim 19. M.P.E.P. §2143.

    B.   <u>Claims 9, 13, 18, 20-22, 32, 36 and 41 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Word '97 in view of Borland.</u>

        1.   <u>Word '97 and Borland, taken singly or in combination, do not teach the following claim limitations.</u>

            a.   <u>Claims 13 and 36 are patentable over Word '97 in view of Borland.</u>

The Office Action asserts that the combination of Word '97 and Borland, taken singly or in combination, do not teach "said user desired offsets being preserved for variables, functions, and constructors" as recited in claim 13 and similarly in claim 36. Office Action (7/6/2009), page 11. However, the Office Action is unclear as to how Word '97 and Borland teach this particular limitation as the Office Action appears to address different limitations. *Id.* Based on Applicants' understanding, the Office Action may be rejecting claims 13 and 36 based on Borland teaching an auto indent mode and persistent blocks for preserving indentation of blocks of code. *Id.* Applicants respectfully traverse the rejections.

Referring first to the persistent blocks option, when the persistent blocks option is on, marked blocks remain selected until they are deleted or unmarked or another block is selected. Borland, page 4. Otherwise, with this option off, moving the cursor after a block that is selected deselects the entire block of text. Borland, page 4. Therefore, persistent blocks have nothing to do with the preservation of indentation of blocks of code as asserted by the Office Action. With respect to the auto indent mode, when auto indent mode is on in Borland, pressing enter in an edit window positions the cursor under the first non-blank character in the preceding non-blank line. Borland, page 3. Thus, Borland does not teach preserving user desired offsets for variables, functions and constructors. Neither does Borland teach while parsing a user example document, preserving the relative indentation of

subcomponents by calculating user desired offsets for the subcomponents, as recited in claim 12 from which claim 13 depends. Plainly, neither Word '97 nor Borland teach all of the limitations of claim 13.

Therefore, the cited passages of Word '97 and Borland do not teach the above-cited claim limitations in claims 13 and 36 as asserted by the Office Action.

      b.   <u>Claim 18 is patentable over Word '97 in view of Borland.</u>

The Office Action asserts that Word '97 and Borland, taken in combination, teach "a plurality of grammar templates, each said template for storing syntax rules for a unique one of a plurality of programming languages" as recited in claim 18. Office Action (7/6/2009), page 11. In particular, the Office Action admits that Word '97 does not teach a grammar template for storing syntax rules. *Id.* The Office Action contends (citing Word '97, page 2), however, that Word '97 teaches analysis of user input "Dear John," which analysis is dependent upon syntactical and pattern matching review of the words and punctuation of the input. *Id.* at pages 11-12. Applicants have addressed this assertion in conjunction with claim 17. Applicants have previously shown that Word '97 does not suggest an analysis dependent upon syntactical and pattern matching review of words and punctuation of the input. Further, there is no language in either Word '97 or Borland that refers to syntax rules as recited in claim 18. Therefore, the cited passages of Word '97 and Borland do not teach the above-cited claim limitation in claim 18 as asserted by the Office Action.

Further, the Office Action admits that Word '97 does not teach rules for programming languages or of declaration/definition files. Office Action (7/6/2009), page 12. While Applicants agree with the Office Action's statement, the statement is not pertinent to the invention of claim 18. Claim 18 does not refer to rules for programming languages or declaration/definition files. Claim 18 recites a template for storing syntax rules for a unique one of a plurality of programming languages. Neither does the Office Action's allegation with respect to Borland as teaching an editor specifically tailored to edit text, as well as editing C++ text files, comprising declaration/definition files address the limitations of claim 18. *Id.* A text editor for

editing declaration files is not a template for storing syntax rules for a unique one of a plurality of programming languages. Furthermore, declaration/definition files, commonly referred to as header files, are not templates for storing syntax rules as recited in claim 18. As is well known in the art, C and C++ are strongly typed languages in which all variables, functions, etc., must be declared as to type before they are defined. Commonly this is done in a header file, and further, it is standard practice to denote header files with a .h file extension. Thus, neither Word '97 nor Borland, alone or in combination, teach the limitations of claim 18. Therefore, the cited passages of Word '97 and Borland do not teach the above-cited claim limitation in claim 18 as asserted by the Office Action.

> c.   Claim 20 is patentable over Word '97 in view of Borland.

The Office Action cites pages 1, 6 and 7 of Borland as teaching "said input document files including a declaration example file and a definition example file" as recited in claim 20. Office Action (7/6/2009), page 12. The Office Action cites pages 1, 6 and 7 of Borland as teaching the above-cited claim limitation since Borland allegedly teaches an edit specifically tailored to edit text, as well as editing C++ text files, comprising declaration/definition files, e.g., #include<stdio.h>. *Id.* Applicants respectfully traverse.

Applicants do not dispute that the text editor of Borland might be used to edit declaration files, such as stdio.h. However, a text editor is not an input file nor is a C++ header file either a declaration example file or a definition example file. Therefore, the cited passages of Borland do not teach the above-cited claim limitation in claim 20 as asserted by the Office Action.

> d.   Claims 22 and 41 are patentable over Word '97 in view of Borland.

The Office Action asserts that Word '97 and Borland, taken in combination, teach "at least one grammar template file, one said grammar template file for each of one or more sections of an output document in one or more programming languages, each said grammar template file for specifying the manner for parsing and defining

the bounds of a section of said output document; and at least one style template parsed from a user example document in a user preferred style using said grammar template file for defining the style of a section of said output document" as recited in claim 22 and similarly in claim 41. Office Action (7/6/2009), page 12.

The Office Action contends that Word '97 teaches analysis of user input "Dear John," the analysis dependent upon syntactical and grammatical review of the words and punctuation of the input, which purportedly teaches the limitation in claim 22 directed to "grammar." Office Action (7/6/2009), page 13. Applicants respectfully disagree.

Word '97 teaches that the user enters "Dear" or "To" followed by a name and colon or comma. Word '97, page 2. Word '97 further teaches that if the Letter Wizard does not start in response, the user did not enter a comma or colon after the person's name or the user misspelled "Dear" or "To." Word '97, page 7. There is no language in Word '97 that teaches syntactical and grammatical review of the words and punctuation of the input.

Furthermore, the Office Action admits that Word '97 does not teach parsing. Office Action (7/6/2009), page 13. Nevertheless, the Office Action contends that Word '97 teaches analyzing initial user inputted words and punctuation which provides the equivalent of parsing text components. *Id.* This allegation fails as indicated below.

As an initial matter, asserting that Word '97 teaches analyzing initial user inputted words and punctuation is an overstatement of the teaching in Word '97. Word '97 teaches that if the user enters "Dear" or "To" followed by a name followed by a colon or comma, the "Letter Wizard" will start and ask the user if the user would like help. Word '97, pages 2, 7, 9. There is no evidence to support the alleged analysis of inputted words and punctuation, and indeed, the demonstration above contradicts this assertion.

Furthermore, Applicants respectfully assert that claim 22 does not recite parsing of components, but a grammar template file for specifying the manner for parsing and defining the bounds of a section of the output document. All words in a

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claim must be considered when judging the patentability of the claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. 2143.03. Since the Office Action has not considered all the words in claim 22 in judging the patentability of claim 22, the Office Action has not presented a *prima facie* case of obviousness in rejecting claim 22. M.P.E.P. §2143.

Furthermore, the Office Action admits that Word '97 does not teach templates for programming languages. Office Action (7/6/2009), page 13. As an initial matter, this does not address the limitations of claim 22. Claim 22 does not recite templates for programming languages, without more. All words in the claim must be considered when judging the patentability of the claim. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. 2143.03. The foregoing notwithstanding, the Office Action contends that Borland teaches a text editor for editing text and C++ programming files. *Id.* Whether Borland does teach such a text editor is immaterial to the rejection of claim 22. There is no evidence, or even an allegation that Borland teaches templates as recited in claim 22.

Therefore, the cited passages of Word '97 and Borland do not teach the above-cited claim limitations in claims 22 and 41 as asserted by the Office Action.

> 2. Office Action's reasoning for modifying Word '97 with Borland to include the missing claim limitations of claims 13, 18, 20, 22, 36 and 41 is insufficient to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, the Office Action must provide articulated reasoning with some rational underpinning. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)).

The Office Action's reasoning for modifying Word '97 with Borland to have the user desired offsets being preserved for variables, functions and constructors, as recited in claim 13 and similarly in claim 36, is to provide Word '97 "the benefit of enhancing its templates to accommodate various text files." Office Action (7/6/2009), page 11. Further, the Office Action's reasoning for modifying Word '97 to have a plurality of grammar templates, as recited in claim 18, is to provide Word

'97 "the benefit of rules for making accurate analysis." *Id.* at page 12. Further, the Office Action's reasoning for modifying Word '97 with Borland to have a plurality of grammar templates, each template for storing syntax rules for a unique one of a plurality of programming languages, as recited in claim 18, is to provide Word '97 "the benefit of enhancing its templates to accommodate various text files." *Id.* Further, the Office Action's reasoning for modifying Word '97 with Borland to have input document files include a declaration example file and a definition example file, as recited in claim 20, is to provide Word '97 "the benefit of enhancing its templates to accommodate various text files." *Id.* Further, the Office Action's reasoning for modifying Word '97 to have at least one style template parsed from a user example document in a user preferred style using the grammar template file for defining the style of a section of the output document, as recited in claim 22 and similarly in claim 41, is to provide Word '97 "the benefit of text analysis/matching for presentation of various templates." *Id.* at page 13.

While the Office Action may consider many factors in finding a reason to combine, the Office Action still must explain how the Examiner derived the motivation for modifying Word '97 to include the above-cited missing claim limitations. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007). Furthermore, the Office Action must provide some rational connection between the Office Action's reasoning for modifying Word '97 with Borland and the missing claim limitations. For example, what is the rational connection between having the user desired offsets being preserved for variables, functions and constructors (missing claim limitation) and enhancing its templates to accommodate various text files (Office Action's reasoning)?

Hence, the Office Action's rationales do not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Word '97 to include the above-cited missing claim limitations of claims 13, 18, 20, 22, 36 and 41. Accordingly, the Office Action has not presented a *prima facie* case of obviousness for rejecting claims 13, 18, 20, 22, 36 and 41. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

V.   ALLOWABLE SUBJECT MATTER:

Applicants thank Examiner Campbell for the indication of allowability of claim 23.
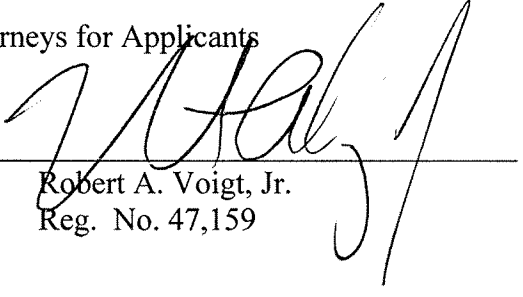
VI.   CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 1-13, 16-36 and 40-43 in the Application is in condition for allowance, and Applicants respectfully request an allowance of said claim. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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